

**d.) Remarks.**

Applicant has amended claims 1, 3-6, 9, 29, 31 and 35. Support for these amendments can be found in the claims themselves and throughout the specification. For example, support the aspects of “automatically rearranging” and “displaying a preview” are set forth within the claims themselves and, among others, also within pending claims 12 and 3, respectively. Accordingly, no new matter or new issues are presented with these amendments. Claims 1-40 are currently pending with claims 16-28 and 38-40 withdrawn. Upon allowance of only the examined claims, the withdrawn claims will be canceled and re-filed as a divisional application.

Item 1. This item does not require a response.

Item 2. Claims 1-8 stand rejected, under 35 U.S.C. § 101, as allegedly directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Patent Office stated that “processing the user selection” may be no more than an individual writing down information on a piece of paper. Applicant respectfully disagrees.

Claim 1 has been amended to require: “automatically rearranging the selected product reference to the selected format to create a preview of the proposed advertisement; and displaying the preview to the user.” The step of “automatically rearranging” clearly is not a step performed by a human. This step also provides the benefit that a human does not have to rearrange the product reference for the selected format. Thus, this step is performed by a computer and produces a “useful, concrete, and tangible result.” See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373. The arguments previously presented in the Response filed November 29, 2004 are also reasserted. Therefore, it is respectfully submitted that claim 1, as amended, is directed to statutory subject matter. As claims 2-8 depend from claim 1, claims 2-8 are also directed to statutory subject matter.

Item 3. Claims 1-15 and 29-37 stand rejected, under 35 U.S.C. § 103(a), as allegedly obvious over Matsumoto et al., U.S. Patent 6763334. Applicant respectfully traverses this rejection.

The Patent Office stated that the term “preview of the proposed advertisement” does not define over Matsumoto, in view of common knowledge, i.e. previewing proposed advertisements for review by a user, e.g. a graphic artist working/displaying with a template and displaying a plurality of product references for review while working on a design layout to come up with a final proof.” The Patent Office stated that “[T]he motivation for doing such would have been to incorporate common knowledge advertising methods and enable them over a computer network.” Applicant respectfully disagrees.

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Roy*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.A. 1974).

If the claimed subject matter is an obvious extension of the art described in Matsumoto, it would have been implemented earlier. However, the lack of implementation supports Applicant’s argument that the subject matter is allowable. “That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness.” *Fromson v. Anitec Printing Plates, Inc.*, 45 U.S.P.Q.2d 1269 (Fed. Cir. 1997).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

Matsumoto does not disclose or suggest a system and method for a user to create “a proposed advertisement for a plurality of products for display on a computer.” (Office Action dated October 19, 2004, page 3, item 5, second paragraph.) Rather Matsumoto merely discloses

“arranging advertisements on a network for a potential media owner ... to sell ad space on a network media to an advertiser.” (Matsumoto:, Abstract; Col. 4, lines 55-63.) It should be noted that Matsumoto merely lists ad space available and allows an advertiser to select the ad space and specify the conditions under which the ad will be run. (Matsumoto: Col. 1, lines 40-53; Col. 4, lines 55-63; Col. 7, lines 7-9 and 51-53.) The media owner can accept or reject the proposed contract from the advertiser. (Matsumoto: Col. 1, line 65 – Col. 2, line 2; Col. 6, line 59 – Col. 7, line 4.) Note that the “conditions” are not concerned with the details of the advertisement, but are concerned with the results of the advertisement. (Matsumoto: Col. 2, lines 3-26; Col. 5, lines 24-54.) Upon acceptance of the contract, the advertisement is placed on the selected ad space of the network media. (Matsumoto: Col. 2, lines 3-26.) Therefore, Matsumoto cannot be said to do any preview of an advertisement; rather, if the space is available and the advertiser wants it, and the media owner is willing to agree to the conditions of the advertiser, then the advertisement is placed in the space: no preview is suggested or required.

Further, Matsumoto neither suggests nor discloses “displaying on a computer a plurality of advertising formats for selection by the user”, Matsumoto merely indicates what advertising space is available. Also, Matsumoto neither suggests nor discloses “displaying on the computer, in response to selection [of the advertising format] by the user, a template that corresponds to a selected one or more of the plurality of advertising formats”, Matsumoto merely indicates what advertising space is available. Further, Matsumoto neither suggests nor discloses “displaying on the computer a plurality of product references for selection by the user”, Matsumoto simply allows the advertiser to place his own advertisement in the selected advertising space. In addition, Matsumoto neither suggests nor discloses “displaying on the template at least one selected product reference to create a proposed advertisement”, Matsumoto does not have a template. Finally, Matsumoto neither suggests nor discloses “automatically rearranging the selected product reference to the selected format to create a preview of the proposed advertisement”, Matsumoto merely discloses that the media owner shows what space is

available, and the advertiser takes it or not. Matsumoto does not even mention rearrangement of the product reference to a selected format, or a preview of the advertisement. A preview of the advertisement is neither warranted nor motivated as the advertiser has already created the advertisement and is just looking for a space to place it. Therefore, it is respectfully submitted that claim 1, and its dependent claims 2-8, are patentable over Matsumoto.

Independent claims 9, 29 and 31 have been amended to require “automatically rearranging the selected product reference to the selected format to create, at the remote site, a preview of the proposed advertisement.” As stated above with respect to claim 1, Matsumoto neither suggests nor discloses automatic rearrangement of a product reference to a selected format. The other arguments above regarding the patentable differences between claim 1 and Matsumoto are also applicable here but need not be belabored by restating them. Therefore, it is respectfully submitted that independent claim 9 and its dependent claims 10-16, independent claim 29 and its dependent claim 30, and independent claim 31, are all patentable over Matsumoto.

Independent claim 32 has not been amended, and requires “importing the selected product reference onto one of the plurality of advertising areas to create an advertisement, whereby said advertising area is configured to automatically format the selected product reference to fit within physical dimensions of the advertising area.” (Emphasis added.) It is believed that the Patent Office inadvertently overlooked the requirement to automatically format. However, that requirement exists and Matsumoto does not suggest or disclose, or even suggest a need for, such automatic formatting. The other arguments above regarding the patentable differences between claim 1 and Matsumoto are also applicable here but need not be belabored by restating them. Therefore, it is respectfully submitted that independent claim 32, and its dependent claims 33-34, are patentable over Matsumoto.

Independent claim 35 has been amended to require “generating an advertisement whereby the plurality of product references are automatically placed onto the plurality of advertising areas

in accordance with the at least one rule of priority.” (Emphasis added.) Matsumoto neither suggests nor discloses automatic placement of product references into advertising areas in accordance with a priority rule. Matsumoto, as discussed above, is a system whereby an advertiser can buy media space. The other arguments above regarding the patentable differences between claim 1 and Matsumoto are also applicable here but need not be belabored by restating them. Therefore, it is respectfully submitted that independent claim 35 and its dependent claims 36-37 are patentable over Matsumoto.

Therefore, it is respectfully submitted that independent claims 1, 9, 21, 31, 32 and 35, and their dependent claims 2-8, 10-15, 22-30, 33, 34, 36 and 37, are patentable over Matsumoto.

Item 4. The Patent Office cited Rosenlund et al., U.S. Patent 6,738,155, as disclosing “Applicant’s inventive concept of a graphic artist using a computer network and template for reviewing proposed advertising.” However, the Patent Office did not relate or apply this to any particular claim.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . . .") (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), <sup>6</sup> the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.<sup>1</sup>

It will be noted that Rosenlund only suggests allowing the end user to find and edit a pre-existing product file and save it as a new file. Rosenlund neither suggests nor discloses the steps of claim 1 of displaying a plurality of advertising formats, displaying a template that corresponds to a selected format, displaying a plurality of product references, or automatically rearranging a selected product reference to the selected format to create a preview of a proposed advertisement. Similarly, Rosenlund neither suggests nor discloses the same or similar steps of independent claims 9, 29, 31, 32 and 35. In addition, Rosenlund neither suggest nor discloses the different automatic steps of independent claims 32 and 35.

Neither Matsumoto nor Rosenlund disclose, teach, or suggest automatic formatting or automatic placement. Furthermore, there is no suggestion or motivation found in Matsumoto nor Rosenlund, nor any other prior art of record, and it would not have been obvious to one of ordinary skill in the art, to modify the advertising space contract system of Matsumoto, or to modify the publishing and printing services of Rosenlund, to automatically perform product reference formatting or placement. For these reasons, Applicant respectfully submits that independent claims 1, 9, 21, 31, 32 and 35, and their dependent claims 2-8, 10-15, 22-30, 33, 34, 36 and 37, are patentable over Rosenlund, singly or in combination with Matsumoto.

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<sup>1</sup> Quoted from WINNER INT'L. ROYALTY v WANG No. 981553 - 01/27/2000 (CAFC).

Item 5. This item does not require a response.

Item 6. This item does not require a response.

### **Conclusion**

The application is in condition for allowance and the prompt issuance of a Notice of Allowance is respectfully requested. If there are any fees due with the filing of this Amendment, including any fees for an extension of time, applicant respectfully requests that extension and also requests that any and **all fees due be charged to Deposit Account No. 50-1682, referencing Attorney Docket No. 144797.00100**

Respectfully submitted,  
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